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MYERS BIGEL SIBLEY & SAJOVEC, P.A.
P.O. BOX 37428
RALEIGH, NC 27627

EXAMINER

LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,325

Applicant(s)

DESAI, WEALTHY

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-16,19-30,32,34-44,47-58,60,62-72 and 75-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-16,19-30,32,34-44,47-58,60,62-72 and 75-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 19, 2007, has been entered.

Response to Amendment

Applicant's amendments and remarks filed October 19, 2007, are responsive to the office action mailed August 14, 2007. In this response, applicant has amended claims 1, 29, and 57. Applicant has previously cancelled claims 3, 5, 17-18, 31, 33, 45-46, 59, 61, and 73-74. Claims 1-2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72, and 75-85 are therefore pending and examined in this office action.

Response to Arguments

Applicant's arguments with respect to claims 1, 29, and 57 have been considered but are moot in view of the new ground(s) of rejection. Notwithstanding the above, the examiner has made certain observations that may help further prosecution.

Pertaining to rejection of claims under 35 USC §103(a) in the previous office action

Examiner notes that, while randomly archived webpages downloaded from the internet archive do provide clear disclosure of the elements contained therein, they are quite definitely not comprehensive disclosures of the length and breadth of the underlying prior art invention. The internet archive stores webpages at random unless a particular page is searched in the archive. If a particular page is searched and found to have not been previously saved, the internet archive notes that it will be archived on its next pass. In addition, it would be contrary to the previous inventors' interests to place an invention in public use before securing intellectual property rights. Therefore, not only are archived webpages an incomplete source for determining the extent of a disclosure, but the more inventive aspects of the invention are more likely to not be included in archived prior art webpages than to be included therein. In determining what invention a published US Patent discloses it is therefore suggested to look to the published patent as it would be understood by a person of ordinary skill in the art. Examiner also suggests, if sufficient functionality is disclosed in the specification, that the applicant devote more attention to establishing in the claims the uniqueness and individualized nature of each listing, and the calculation of price for said listing in a unique, individualized basis. As currently claimed, for example, "a customized listing" and "individually selectable available optional listing enhancements" could apply to packages of offered enhancements. It appears the listings described in the present application may be restricted to certain uniform options. If singularly unique listings are enabled by the specification, the examiner requests the applicant refer to the location of

said enablement within the originally filed specification. This would of course require a difference of more than just the mere nonfunctional details of the business itself.

With regard to claim 16, applicant argues at length that billing information has a vast range of functions that cannot be achieved with any other information, such as address, contact, or other identifying information. This is true. As is true of virtually all information, different information can be put to different functions. Unfortunately, none of these functions is claimed. As claimed, the billing information is not functional because it has no function in the claims and no effect on the method. The solicitation for information is displayed, and in response information is received. That being the only function, the exact information is irrelevant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-2,4,6-16,19-30,32,34-44,47-58,60,62-72, and 75-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamburt (Paper #20061105; US Patent No.6,374,241).**

Lamburt teaches a providing a business directory, soliciting orders for listings in a business directory, providing a website accessible by customers, displaying listing options and enhancements available to customers for enhancing their business listings,

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and displaying price quotes for customized business listings. For example, Lambert discloses a method for providing a Web site accessible by a customer and receiving an order request from the customer via the Web site to place an order for a customized business listing in a business directory including at least one optional listing enhancement requested by the customer (see at least figs.10-22. Lamburt further discloses:

- displaying at the Web site a list of multiple individually selectable available optional listing enhancements: (see at least abstract, figs.16-22,36, column 10 lines 45-53, column 54 lines 33-53);
- soliciting at the website a selection by the customer: of one or more of the optional listing enhancements (see at least figs.16-22, column 10 lines 45-53, column 54 lines 33-53).
- receiving at least one request from the customer via the Web site: to include at least one feature in the listing of the business in the business directory, including receiving an enhancement request from the customer via the Web site to include in the listing of the business in the business directory at least one optional listing enhancement from the list of available optional listing enhancements whereby the customer configures a customized business listing, request from the customer to place the order for the listing of a business in a business directory including the at least one optional listing enhancement requested by the customer (see at least abstract, figs.16-22,36, column 10 lines 45-53, column 54 lines 33-53);

- generating a customized price quote for the particular customized business listing configured by the customer: displaying the customized price quote for the customized business listing at the website to the customer (see at least figs.16-22, column 10 lines 45-53, column 54 lines 33-53. Please note: The figures indicate that this reference is a US Patent drawn to the same invention previously evidenced by the non-patent literature Lambert or that they are both within the same family of inventions. Lambert however is a more thorough disclosure, showing and describing a greater degree of functionality than is evidenced by the archived webpages available in support of the previously cited Lambert reference.)
- the business directory is a classified business directory: (see at least figs.3,9-22,43-44).
- displaying to the customer at the Web site a solicitation to enhance the listing: with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee (see at least figs.16-22); receiving listing information from the customer at the Web site, wherein the listing information includes basic business information (see at least figs.16-22).
- receiving listing information from the customer at the Web site: the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: basic

business information including a business name, a business address, and a business telephone number, business market information including a region or market in which the customer wishes the business listing to appear, business category information including at least one business category under which the customer wishes to list the business in the business directory, also providing for at least two categories under which the customer wishes to list the business in the business directory (see at least figs.9,11-17,19-21,41,44,54-58,68-70); displaying at the Web site a list of available business categories and subcategories and receiving from the customer at the Web site a selection of a business category and subcategory from the list of available business categories and subcategories (see at least figs.9,11-17,19-21,41,44,54-58,68-70).

- receiving listing information from the customer at the Web site: the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: including optional listing enhancement information that includes graphical and/or textual indicia the customer wishes to appear on the listing in the business directory, the graphical and/or textual indicia including at least one of a customer Web site link, a customer email link, enhanced text, listing highlighting, and a link to a supplemental listing, including a link to an enhanced listing, further including receiving supplemental information from the customer at the Web site that the customer wishes to be displayed when the link to the supplemental listing is

accessed by a directory user, and also including receiving enhanced text information from the customer at the Web site that the customer wishes to appear on the listing in the business directory (see at least figs.3,9,15-22,42,44,46,54-55; column 1 lines 8-34, column 10 lines 45-56).

- displaying at the web site a solicitation for billing information from the customer: receiving billing information from the customer at the Web site (see at least fig.22. Please note: The customer's identifying information, whether it is called contact information or billing information, is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).
- generating a price quote: for the business listing ordered by the customer and displaying the price quote to the customer at the Web site, calculating the price quote based on features requested by the customer to be included in the business listing (see at least figs.16-17,19-20,33).
- displaying a statement of terms and conditions to the customer at the Web site: and receiving confirmation of acceptance of the terms and conditions from the customer at the Web site (see at least figs.19-20, column 18 lines 14-29).
- generating an order confirmation and displaying it to the customer: at the Web site (see at least abstract, figs.19-20,22,36; column 10 lines 18-45. Please note:

it is an inherent aspect of the "Purchase Ads Online" option and the option to see how the listing appears that the order confirmation would then be displayed to the customer, at least in the form of showing the customer's listing).

- the order serving to provide enhancements to an existing business listing: in the business directory (see at least figs.16-17,19,54-55; column 10 lines 45-51, column 55 line 48-column 56 line 37).
- business directory is an online business directory: (see at least figs.9-22).
- sending the customer an email: including information regarding the order for the listing in the business directory (see at least fig.22; column 16 lines 32-50).

Pertaining to system Claims 29-30,32,34-44, and 47-56

Rejection of Claims 29-30,32,34-44, and 47-56 is based on the same rationale as noted above (Please note: the means for accomplishing each step of the method as disclosed in the reference is either disclosed or inherent in each specific section of the reference that discloses the step in the method).

Pertaining to computer program product Claims 57-58,60,62-72, and 75-84

Rejection of Claims 57-58,60,62-72, and 75-84 is based on the same rationale as noted above. In addition, Lamburt discloses a computer program product (see at least abstract, column 22 line 66-column 23 line 11, column 68 lines 16-39).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
December 25, 2007


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600